



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,133	09/25/2001	William Stevens Taber JR.	20162-000310US	1723

20350 7590 08/20/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

[REDACTED] EXAMINER

BORISOV, IGOR N

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3629

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/964,133	TABER, WILLIAM STEVENS	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 September 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, the numeratrion of the method steps is confusing.

As per claims 2-23, these claims are rejected as being dependent from claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. (US 6,535,859) in view of Hickman et al. (US 6,105,000).

Yablonowski et al. teach a method and system for maintaining lighting systems and for monitoring energy consumption of the lighting sytems, comprising:

As per claims 1-2, 4-5 and 18-21,

Art Unit: 3629

auditing by said implementing entity of energy using equipment at said multiple end user sites, said audit identifying energy using equipment at said sites that is a candidate for replacement with energy efficient equipment performing an equivalent task, said replacement resulting in saved energy (Abstract; column 3, lines 17-20; column 5, lines 53-65; column 6, line 24 through column 7, line 26; column 7, lines 42-63);

procuring by said implementing entity of said energy efficient end user equipment from a supplier of said equipment (Abstract; column 3, lines 17-20; column 5, lines 53-65; column 6, line 24 through column 7, line 26; column 7, lines 42-63);

deploying by said implementing entity of an energy saving replacement for least one said candidate for replacement with said energy efficient equipment at no cost to said end users (column 7, lines 9-11; column 8, lines 26-27);

measuring by said implementing entity of said saved energy at said sites using a method of measurement agreed upon by said end users and said implementing agency (column 7, lines 25-26, 42-63).

Yablonowski et al. do not specifically teach for selling by said implementing entity of said saved energy to said end users at a price that is less than the price of energy purchased from an energy generating company.

Hickman et al. teach a method and system for financial rebate program that provides rebates to purchasers or sellers of energy, wherein, when a utility does not need all of the power it purchased, it may sell the excess power at a discount.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yablonowski et al. to include selling by said implementing

Art Unit: 3629

entity of said saved energy to said end users at a price that is less than the price of energy purchased, because it would stimulate end users to replace the old equipment with more energy efficient equipment.

As per claim 3, Yablonowski et al. teach said method and system, wherein said deployment at said multiple end user sites is performed in a coordinated manner (column 6, line 54 – column 7, line 41).

As per claim 6, Yablonowski et al. teach all the limitations of claim 6, except that auditing is performed by an auditor specializing in evaluating the potential energy saving for a selected type of said energy saving equipment rather than a generalist energy auditor.

Official notice is taken that it is old and well known that auditing is performed by an auditor specializing in his task rather than a person having general knowledge of the art.

Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yablonowski et al. to include that auditing is performed by an auditor specializing in evaluating the potential energy saving for a selected type of said energy saving equipment rather than a generalist energy auditor, because it would allow to minimize possible mistakes in auditing, thereby minimizing potential financial losses.

As per claims 7-9 and 12, Yablonowski et al. teach said method and system, wherein actual cost, rather than estimated cost, of said energy saving equipment is utilized to project financial feasibility for said deployment by said implementing entity (column 6, lines 24 – column 7, line 26; column 7, lines 42-63).

As per claim 10, Yablonowski et al. teach said method and system, further comprising methods to reduce financial risk to said implementing entity (column 6, lines 24-29, 54-56).

As per claim 11, Yablonowski et al. teach said method and system, wherein said procurement is performed in a volume sufficient to increase profit of said sale of saved energy to a preselected amount (column 6, lines 54-56).

As per claims 16-17, Yablonowski et al. teach said method and system, wherein said implementing entity receives an incentive from an energy utility company to undertake said procurement, said deployment and combinations thereof (column 1, lines 25-28).

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. and Hickman et al. in view of Adams et al. (US 6,154,730).

As per claims 13 and 14, Yablonowski et al. and Hickman et al. teach all the limitations of claims 13 and 14, except that mode of financing is credit enhancement.

Adams et al. teach a method and system for facility-based financing, wherein credit financing is employed (column 4, lines 9-12).

It would have been an obvious matter of design choice to modify Yablonowski et al. and Hickman et al. to include that mode of financing is credit enhancement, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Yablonowski et al. and Hickman et al. would perform the invention as claimed by the applicant with any mode of financing.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. and Hickman et al. in view of King (US 6,148,293).

As per claim 15, Yablonowski et al. and Hickman et al. teach all the limitations of claim 15, except that mode of financing includes tax-exempt, floating rate.

King teaches a method and system for creating a financial instrument and administering an adjustable rate loan system, wherein tax-exempt, floating rate is employed (column 6, lines 11-40; column 17, lines 16-26).

It would have been an obvious matter of design choice to modify Yablonowski et al. and Hickman et al. to include that mode of financing includes tax-exempt, floating rate, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Yablonowski et al. and Hickman et al. would perform the invention as claimed by the applicant with any mode of financing.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. and Hickman et al. in view of Wallman (US 6,360,210).

As per claim 22, Yablonowski et al. and Hickman et al. teach all the limitations of claim 22, except that risk of inadequate energy saving equipment performance is undertaken by a party other than said implementing entity or said end user.

Wallman teaches a method and system for enabling smaller investors to manage risk in a self-managed portfolio of assets, wherein a risk for a given project (portfolio) can be transferred to a third party (Abstract; column 5, line 64 – column 6, line 8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yablonowski et al. and Hickman et al. to include that risk of inadequate energy saving equipment performance is undertaken by a third party, because it would stimulate end users to replace the old equipment with more energy efficient equipment.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al. and Hickman et al. in view of Johnson (US 6,169,979).

As per claim 23, Yablonowski et al. and Hickman et al. teach all the limitations of claim 23, except for using environmental rebates to stimulate end users to replace the old equipment with more energy efficient equipment.

Johnson teaches a computer-assisted method and system for utilities, wherein environmental rebates are employed (column 5, lines 1-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yablonowski et al. and Hickman et al. to include using environmental rebates to stimulate end users to replace the old equipment with more energy efficient equipment, because it would provide the financial incentives for the end users to reduce pollution and contamination of the environment

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA, 7th floor receptionist.

T. A. Dixon
THOMAS A. DIXON
PRIMARY EXAMINER